

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed June 21, 2006 rejected claims 1, 2, 4-21, and 23-28. This is a full and timely response to that outstanding Office Action. Claims 1, 2, 4-21, and 23-28 are pending, and claims 1, 2, 4, 9 – 11, 14 – 16, 21, 23, and 24 have been slightly amended.

I. Present Status of Patent Application

Claims 1-2, 4-21, and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 1-2, 4-21, and 23-28 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-2, 4-21, and 23-28 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Paul* (U.S. Patent No. 6,052,709). These rejections are respectfully traversed.

II. Rejections Under 35 U.S.C. §112**A. Rejection under 35 U.S.C. §112 (1)**

The Office Action rejects claims 1-2, 4-21, and 23-28 under 35 U.S.C. §112, First Paragraph as allegedly failing to comply with the written description requirement. Applicant refers to the originally filed specification, page 6, lines 14-16; page 7, lines 6-8 and 18-19; and page 13, lines 7-13 for enabling, non-limiting examples of the element, namely, transmitting the outgoing email communication if the domain name is included in the incoming domain name list, otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication. In view of this enabling disclosure, Applicant respectfully submits that the rejection to claims 1-2, 4-21, and 23-28 should be withdrawn.

Additionally, independent claims 8, 18, and 26 do not use the language cited in the rejection. It is unclear in what way claims 8-20 and 26-28 do not meet the written description

requirement of 35 U.S.C. §112 (1). For at least this reason, Applicant respectfully submits that the rejection to claims 8-20, and 26-28 should be withdrawn.

B. Rejection under 35 U.S.C. §112 (2)

The Office Action rejects claims 1-2, 4-21, and 23-28 under 35 U.S.C. §112, Second Paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, namely, transmitting the outgoing email communication if the domain name is included in the incoming domain name list, or otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication. This element is a conditional element. If the domain name is on the list, the email is transmitted, otherwise a prompt is generated. Applicant has also amended claims 1 and 21 to further clarify this condition. Applicant respectfully submits that claims 1-2, 4-21, and 23-28 particularly point out and distinctively claims the subject matter, and that the rejection to claims 1-2, 4-21, and 23-28 should be withdrawn.

Additionally, independent claims 8, 18, and 26 do not use the language cited in the rejection. It is unclear in what way claims 8-20 and 26-28 do not meet the written description requirement of 35 U.S.C. §112 (2). For at least this reason, Applicant respectfully submits that the rejection to claims 8-20, and 26-28 should be withdrawn.

III. Rejections Under 35 U.S.C. §102(e)

A. Claims 1, 2, and 4-7

The Office Action rejects claims 1, 2, and 4-7 under 35 U.S.C. §102(e) as allegedly being anticipated by *Paul* (U.S. Patent No. 6,052,709). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
 - creating an incoming domain name list in a memory;
 - receiving an incoming email communication;
 - extracting a domain name from a sender's email address from the incoming email communication;
 - storing the domain name in the incoming domain name list in the memory;
 - checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the incoming domain name list in the memory; and
 - transmitting the outgoing email communication if the domain name is included in the incoming domain name list, *otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication.*

(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Paul* does not disclose, teach, or suggest at least **otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication**. Even if, *arguendo*, *Paul* discloses an alert signal generator, the alert is not a prompt for a user to confirm an e-mail address associated with the intended recipient of an outgoing e-mail communication if the domain name is not included in the incoming domain name list. Therefore, *Paul* does not anticipate independent claim 1, and the rejection should be withdrawn.

Because independent claim 1 is allowable over the cited references of record, dependent claims 2 and 4-7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2 and 4-7 contain all the features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2 and 4-7 are patentable over *Paul*, the rejection to claims 2 and 4-7 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2 and 4-7 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence, there are other reasons why dependent claims 2 and 4-7 are allowable.

B. Claims 8-17

The Office Action rejects claims 8-17 under 35 U.S.C. §102(e) as allegedly being anticipated by *Paul* (U.S. Patent No. 6,052,709). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 8 recites:

8. A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:
- receiving email communications incoming to the email communications server;
 - creating a domain name database;
 - extracting domain names in sender's e-mail addresses from the e-mail communications incoming to the email communications server;
 - storing extracted domain names in the domain name database;
 - receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network;

searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; and

generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.

(Emphasis added).

Applicant respectfully submits that claim 8 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 8 is allowable for at least the reason that *Paul* does not disclose, teach, or suggest at least **generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled**. Even if, *arguendo*, *Paul* discloses an alert signal generator, the alert does not correspond to the misspelling of the domain name in an e-mail address in an outgoing e-mail communication. Therefore, *Paul* does not anticipate independent claim 8, and the rejection should be withdrawn.

Because independent claim 8 is allowable over the cited references of record, dependent claims 9-17 (which depend from independent claim 8) are allowable as a matter of law for at least the reason that dependent claims 9-17 contain all the features of independent claim 8. Therefore, since dependent claims 9-17 are patentable over *Paul*, the rejection to claims 9-17 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 8, dependent claims 9-17 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence, there are other reasons why dependent claims 9-17 are allowable.

C. Claims 18-20

The Office Action rejects claims 18-20 under 35 U.S.C. §102(e) as allegedly being anticipated by *Paul* (U.S. Patent No. 6,052,709). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 18 recites:

18. An e-mail server for automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

- an interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications;
- a database generator for generating a domain name database for storing domain names extracted from sender's e-mail addresses in incoming e-mail communications; and
- a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications,

wherein ***the e-mail server prompts the user when it detects misspelled domain names in e-mail addresses in outgoing e-mail communications.***

(Emphasis added).

Applicant respectfully submits that claim 18 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 18 is allowable for at least the reason that *Paul* does not disclose, teach, or suggest at least **the e-mail server prompts the user when it detects misspelled domain names in e-mail addresses in outgoing e-mail communications**. Even if, arguendo, *Paul* discloses an alert signal generator, the alert does not correspond to the misspelling of the domain name in an e-mail address in an outgoing e-mail

communication. Therefore, *Paul* does not anticipate independent claim 18, and the rejection should be withdrawn.

Because independent claim 18 is allowable over the cited references of record, dependent claims 19 and 20 (which depend from independent claim 18) are allowable as a matter of law for at least the reason that dependent claims 19 and 20 contain all the features of independent claim 18. Therefore, since dependent claims 19 and 20 are patentable over *Paul*, the rejection to claims 19 and 20 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 18, dependent claims 19 and 20 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence, there are other reasons why dependent claims 19 and 20 are allowable.

D. Claims 21 and 23-25

The Office Action rejects claims 21 and 23-25 under 35 U.S.C. §102(e) as allegedly being anticipated by *Paul* (U.S. Patent No. 6,052,709). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 21 recites:

21. A method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
- creating an incoming email address list in a memory;
 - receiving an incoming email communication;
 - storing, in the incoming email address list in the memory, an email address extracted from the incoming email communication;
 - checking if an e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming email address list in the memory; and

transmitting the outgoing email communication if the e-mail address is included in the incoming email address list, otherwise generating ***a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list.***

(Emphasis added).

Applicant respectfully submits that claim 21 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 21 is allowable for at least the reason that *Paul* does not disclose, teach, or suggest at least ***a prompt for a user to confirm an e-mail address if the domain name is not included in the incoming email address list.*** Even if, *arguendo*, *Paul* discloses an alert signal generator, the alert is not a prompt for a user to confirm an e-mail address associated with the intended recipient of an outgoing e-mail communication if the domain name is not included in the incoming domain name list. Therefore, *Paul* does not anticipate independent claim 21, and the rejection should be withdrawn.

Because independent claim 21 is allowable over the cited references of record, dependent claims 23-25 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 23-25 contain all the features of independent claim 21. Therefore, since dependent claims 23-25 are patentable over *Paul*, the rejection to claims 23-25 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 21, dependent claims 23-25 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence, there are other reasons why dependent claims 23-25 are allowable.

E. Claims 26-28

The Office Action rejects claims 26-28 under 35 U.S.C. §102(e) as allegedly being anticipated by *Paul* (U.S. Patent No. 6,052,709). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 26 recites:

26. An e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server, comprising:

an address extractor for extracting sender's e-mail addresses from incoming e-mail communications;

a previous sender addresses memory for storing e-mail addresses extracted from sender's e-mail addresses in incoming e-mail communications; and

a checker for searching the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications,

wherein the checker generates a prompt for verification of an e-mail address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory.

(Emphasis added).

Applicant respectfully submits that claim 26 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 26 is allowable for at least the reason that *Paul* does not disclose, teach, or suggest at least **wherein the checker generates a prompt for verification of an e-mail address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory**. Even if, *arguendo*, *Paul* discloses an alert signal generator, the alert is not a prompt for a user to confirm an e-mail address associated with the intended recipient of an outgoing e-mail communication upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory. Therefore, *Paul* does not anticipate independent claim 26, and the rejection should be withdrawn.

Because independent claim 26 is allowable over the cited references of record, dependent claims 27 and 28 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 27 and 28 contain all the features of independent claim 26. Therefore, since dependent claims 27 and 28 are patentable over *Paul*, the rejection to claims 27 and 28 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 26, dependent claims 27 and 28 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited references of record. Hence, there are other reasons why dependent claims 27 and 28 are allowable.

V. Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, 4-21, and 23-28 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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